

the Richards et al. patent and the Baker et al. patents are prior art in the United States only as of their common U.S. filing date, which is July 16, 1996.<sup>1</sup> The present application, on the other hand, claims priority to U.S. application Ser. No. 08/567,131, which was filed on December 4, 1995, which is prior to the Richards et al. and Baker et al. U.S. filing dates. Inasmuch as the 08/567,131 priority application discloses pharmaceutical formulations of D-methylphenidate, the cited disclosure of the Baker et al. and Richards et al. patents are not prior art against the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn upon reconsideration.

Claims 1, 2, 7 and 8 are rejected under 35 U.S.C. § 103(a) for alleged obviousness over Patrick et al., J. Pharmacol. Exp. Ther (1997) 241 (1) 152-158 ("Patrick et al.") on the basis that Patrick et al. teaches the administration of D-threo-methylphenidate to mice to assess the pharmacology thereof. However, as discussed above, the administration of D-threo-methylphenidate is disclosed in the 08/567,131 priority application, which was filed prior to the publication date of the Patrick et al. reference. Accordingly, Applicants respectfully request that this rejection be withdrawn upon reconsideration.

Claims 1-6 and 8 are rejected for alleged obviousness type double patenting over claims 1-4, 7-23 and 25-30 of U.S. Patent No. 5,837,284. Applicants submit herewith a terminal disclaimer over the 5,837,284 patent, thus obviating the rejection.

Claims 1-6 and 8 are provisionally rejected for alleged obviousness type double patenting over claim 11 of copending application Ser. No. 09/337,310. Applicants will address this rejection upon the indication of otherwise allowable subject matter in the present application or in the 09/337,310 application.

It is respectfully submitted that this application is now in condition for allowance.

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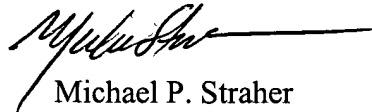
<sup>1</sup> Although the Baker et al. and Richards et al. patents each claim priority to earlier British applications, it will be appreciated that the relevant date for prior art purposes under 35 U.S.C. § 102(e) (and hence, § 103(a)), is their U.S. filing date.

**Docket No: CELG-0121**

**PATENT**

Accordingly, an indication of allowability and an early Notice of Allowance are requested.

Respectfully submitted,



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January 8, 2001

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